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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,924	09/19/2003	Robert G. Everts	10512/41	6463
757	7590	04/14/2005	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			KAMEN, NOAH P	
			ART UNIT	PAPER NUMBER

3747

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/666,924	EVERTS ET AL.	
	Examiner	Art Unit	
	Noah Kamen	3747	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/31/05</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kovacs (DE 3335962) in view of Takada et al (JP 61-39416).

Kovacs proposes to use a four cycle engine for a chain saw. Takada et al disclose a four cycle engine comprising a cam 17, a valve cover 15 on the cylinder head, a splasher 23 that directs lubricant to the recited moving parts of the engine via oil passages 24, 25. Takada et al disclose that an advantage of the invention is a lubrication apparatus, which can lubricate the rocker arm chamber in a reliable and efficient manner with a simple and compact structure. Since this is important for a portable operator carried power tool, one of ordinary skill in the art would combine the engine of Takada with the tool of Kovacs.

Response to Arguments

Applicant's arguments, see the remarks on page 5, filed 3/31/05, with respect to Tuggle have been fully considered and are persuasive. The rejection of claims 14-19 based on Tuggle has been withdrawn.

Applicant's arguments filed 3/31/05 based on Kovacs and Takada have been fully considered but they are not persuasive. The applicants argue that Kovacs fails to explain how the disclosed engine could be used with a chain saw and that the engine is merely directed to an exhaust improvement; therefor the disclosure for use in a chainsaw is speculation. Furthermore, there is no teaching/motivation to combine the lubrication system of Takada et al

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with Kovacs. That to combine the two references would result in an engine incapable of being hand-held/portable. The applicants assert that no hand-held 4-cycle engine was available anywhere else (see 1993 Popular Science, "The Little Engine That Could").

The examiner contends that while Kovacs does not show a clear reduction to practice of a hand-held 4-cycle engine, one of ordinary skill in the art would clearly understand that construction would involve merely miniaturization. The assertion that it had never been done before (at least on a commercial scale) is probably one of expense. Two-cycle engine have fewer parts than and easier to build. It is only with relatively new emission standards that the cost would become a secondary factor. Kovacs fails to disclose details of a lubrication system; therefor, one of ordinary skill in the art would be motivated to use the system of Takada et al for the advantages listed therein. Again, their combination would merely require miniaturization; albeit at a much greater expense. As previously mentioned, the fact that miniature 4-cycle engine had not existed before is deemed not an issue of technology, but one of expediency. Lastly, there are no limitations in the pending claims that deal with novel aspects on how to miniaturize the engine. The claims just recite "lightweight", "hand-held", "portable" with respect to KNOWN ENGINE CONSTRUCTION.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noah Kamen whose telephone number is 571 272 4845. The examiner can normally be reached on M-Th 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Yuen can be reached on 571 272 4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Noah Kamen
Primary Examiner
Art Unit 3747

nk